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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/060,754

01/30/2002

Jeffry B. Skiba

2329-01OU

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43354 7590 05/07/2007  
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EXAMINER

ANDERSON, CATHARINE L

ART UNIT

PAPER NUMBER

3761

MAIL DATE

DELIVERY MODE

05/07/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/060,754

Applicant(s)

SKIBA ET AL.

Examiner

C. Lynne Anderson

Art Unit

3761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 21,24,28,30 and 32-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21,24,28,30 and 32-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5 February 2007 has been entered.

### ***Response to Arguments***

Applicant's arguments filed 5 February 2007 have been fully considered but they are not persuasive.

In response to the applicant's argument that Kang discloses holes and not a conduit, it is noted that the portion of the device of Kang cited as the conduit is the area 11 between the holes (i.e the fog outlets). The conduit of Kang is the open space, having a length greater than its width, between the atomizer and the piece of the mask that bridges the nose. The air holes that connect the conduit to the eye-pieces of the mask are relied upon as the fog outlets. Therefore, Kang does disclose a conduit that fog passes through before being discharged through the fog outlets to the eyes.

In response to the applicant's argument that Kang fails to disclose the atomizer being located a distance away from the device, it is noted that the atomizer of Kang is located atop the conduit 11, and therefore is spaced apart from the eye-pieces of the mask by the distance of the conduit.

In response to the applicant's argument that Kang does not disclose a power supply located distal from the atomizer, it is noted that the present claims do not disclose how far from the atomizer the power supply must be located. The power supply 40 of Kang is located in a separate chamber from the atomizer component, as shown in figure 2, and therefore is located distal from the atomizer.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 21, 28, 30, 32-33, 35, 38-39, 41-42, and 44 are rejected under 35 U.S.C. 102(b) as being anticipated by Kang (5,807,357).

With respect to claims 21 and 30, Kang discloses an apparatus for delivering medicine to tissues, as shown in figure 2, comprising a mask 10 to be worn around the eyes, the mask 10 comprising fog outlets (shown as holes in figure 3, but not numbered). An atomizer 20 atomizes medicine 90 into a fog, which passes through a conduit 11 and is discharged from the fog outlets.

With respect to claim 28, a power supply 40 is located in a separate chamber from, and therefore distal from, the atomizer unit, as shown in figure 2.

With respect to claim 30, Kang discloses a method of providing the mask described above and atomizing fluid into a fog, as disclosed in column 2, lines 27-36.

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The fog comprises an eye treatment solution, or medicine, as disclosed in column 1, lines 37-39.

With respect to claims 32-33, the mask is adapted to be worn around the eyes and comprises a transparent mask face.

With respect to claim 35, the conduit 11 is mounted at the fog outlets, as shown in figure 3.

With respect to claim 38, the atomizer 20 comprises a medication chamber 90, as shown in figure 3.

With respect to claims 39 and 41, the atomizer 20 is located away from the fog outlets by the distance of the conduit 11, as shown in figure 3.

With respect to claim 42, the mask is adapted to be worn around the eyes and comprises a transparent mask face.

With respect to claim 44, the atomizer 20 comprises a medication chamber 90, as shown in figure 3.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kang (5,807,357) in view of Dykstra et al. (5,935,982).

Kang discloses all aspects of the claimed invention but remains silent as to the size of the liquid droplets of the fog. Dykstra discloses administering a medicine to the eyes, the medicine being in the form of liquid droplets having a size of less than 5 microns, as described in column 12, lines 13-15 and 36-37. It would therefore be obvious to one of ordinary skill in the art at the time of invention to make the droplets of Kang less than 5 microns, since Kang teaches less than 5 microns as a suitable size for medicine being delivered to the eyes.

Claims 34 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kang (5,807,357) in view of Fried (5,836,927).

Kang discloses all aspects of the claimed invention with the exception of the fog outlets being centered on the mask face. Fried teaches a mask for administering a medication to the eyes of a user in which the outlets for the medication are centered on the mask face, as shown in figure 1. The placement of the outlets on the mask face allow for the medication to be administered accurately into the user's eyes, as disclosed in column 1, lines 55-60. It would therefore be obvious to one of ordinary skill in the art at the time of invention to place the outlets of Kang on the mask face, as taught by Fried, to allow the medication to be administered accurately into the user's eyes.

Claims 36-37 and 45-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kang (5,807,357) in view of Bertera (5,368,582).

Kang discloses all aspects of the claimed invention with the exception of the mask having rigid ear supports, the ear supports comprising a portion of the conduits. Bertera teaches a mask for administering a medication to the eyes of a user, the mask having rigid ear supports that comprise a portion of the conduits that carry the medication, as shown in figure 1. The rigid ear supports comprising the conduits of Bertera reduce the bulkiness of the apparatus, as disclosed in column 1, lines 54-63. It would therefore be obvious to one of ordinary skill in the art at the time of invention to provide the apparatus of Kang with rigid ear supports, as taught by Bertera, to reduce the bulkiness of the apparatus.

Claims 40 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kang (5,807,357) in view of Hewitt et al. (5,216,759).

Kang discloses all aspects of the claimed invention with the exception of the conduits being flexible. Hewitt discloses goggles of a similar construction to the mask of Kang, and teaches constructing the mask using a flexible material in order to allow the mask to conform to the wearer, as disclosed in column 3, lines 47-52. A mask that conforms to the face of the wearer provides a secure fit, which would ensure the fog discharged into the mask of Kang would not escape the mask, and therefore the mask of Kang would be more effective in delivering the fog to the eyes of the wearer. If the mask of Kang is constructed from a flexible material, the conduits, which comprise part of the mask, would also be flexible.

It would therefore be obvious to one of ordinary skill in the art at the time of invention to construct the mask of Kang out of a flexible material, as taught by Hewitt, to allow the mask to conform to the wearer and provide a secure fit.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent 5,171,306 discloses a mask for providing a medicament to the eyes.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Lynne Anderson whose telephone number is (571) 272-4932. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tanya Zalukaeva can be reached on (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

*CNA*

cla

April 27, 2007

TATYANA ZALUKAEVA  
SUPERVISORY PRIMARY EXAMINER

A handwritten signature in black ink, appearing to read 'T. Zalukaeva', with a long, sweeping horizontal line extending to the right.